

Remarks

The Final Office Action mailed October 13, 2005, and the Advisory Action dated February 3, 2006 have been carefully reviewed and the following remarks are made in consequence thereof.

In accordance with 37 C.F.R. 1.136(a), a one month extension of time is submitted herewith to extend the due date of the response to the Office Action dated October 13, 2005 for the above-identified patent application from January 13, 2006, through and including February 13, 2006. In accordance with 37 C.F.R. 1.17(a)(1), authorization to charge a deposit account in the amount of \$120.00 to cover this extension of time request also is submitted herewith. The present response is therefore timely submitted with the accompanying Request for Continued Examination (RCE).

Applicants will now consider the position taken in the Advisory Action in Part I of this response and the Final Office Action in Part II of this response, respectively. According to the Advisory Action, Applicants' previously filed Response to Final Office Action was not entered in the case on procedural grounds. Consequently, in the present Response, Applicants are resubmitting the previous response in its entirety in Part II, together with remarks in Part I directed to the procedural issues raised in the Advisory Action. That is, the Final Office Action section in Part II of this response is essentially a resubmission of the response that was not entered per the Advisory Action, and Applicants request entry and consideration of the same in light of the remarks in Part I relating to the Advisory Action.

I. The Advisory Action

In the Advisory Action, the declaration accompanied with Applicants' previously submitted response was not entered because Applicants failed to provide a showing of good and sufficient reasons why the declaration is necessary and was not earlier presented. Applicants submit, however, that the declaration was timely and properly presented when viewed in context of the present prosecution. Applicants further submit that the declaration is not necessary, but is sufficient, to overcome the outstanding rejections to the claims, and has been submitted for

expediency to obtain allowance of the claims rather than as any acknowledgement that the present references are suggestive of the present invention..

The Weikhorst et al. reference that prompted the declaration at issue was first cited in the Office Action dated May 27, 2005. While Applicants could have presented a declaration at that time to overcome the rejection, in light of the apparent differences between the Weikhorst et al. and the presently claimed invention, Applicants submitted arguments against the rejection based upon those differences. In response, the Office did not appear to recognize or appreciate such differences and issued a Final Office Action dated October 13, 2005 stating that Applicants arguments were considered but not persuasive. Faced with the final rejection of the claims, it became apparent that submission of a declaration would avoid further prosecution expense and would definitively resolve the outstanding rejections. As such, the declaration was submitted, only to be refused entry on the ground that good and sufficient reasons why the declaration is necessary and was not earlier presented.

To clarify the record, Applicants respectfully traverse the notion that the declaration is necessary to patentability of the claims. Applicants believe that the Weikhorst et al. reference, considered separately or in combination with other references, neither describes nor suggests the present invention. However, faced with the practical expense of appealing the final rejection of the claims based on Weikhorst et al., Applicants chose to avail themselves of an alternative, and more expedient, basis to overcome the rejection by submitting a declaration antedating the Weikhorst et al. reference. Submission of the declaration after first attempting to overcome the rejection based upon argument alone is not believed to be improper or inappropriate. Nothing in the applicable rules states that declaration evidence must be submitted at the first available opportunity in prosecution, or that an Applicant must simultaneously pursue all possible means to overcome a rejection. Applicants' submission of the declaration immediately after the Office's negative treatment of the argument in the Final Office Action is certainly timely and reasonably presented. To the extent that the Office believes that the declaration has not been timely submitted, Applicants request an explanation for this belief, together with any authority relied upon to support the Office's position. On the present record, Applicants submit that there is no reasonable basis to question why the declaration was not submitted earlier.

Incidentally, the declaration at issue also antedates the Koyasu reference, although the declaration was not provided for that purpose. Rather, the declaration was submitted to antedate Weikhorst et al., the newly cited primary reference asserted in the outstanding rejections. Only because of the particular dates associated with the declaration does it turn out that Koyasu is also antedated.

Koyasu was cited as a single reference in an obviousness rejection to claims 1 and 2 in the first Office Action in the case dated May 17, 2004 and was asserted in combination with other references in subsequent Office Actions. Based upon differences between the Koyasu disclosure and the present claims, however, Applicants have successfully argued against and have overcome all prior rejections of the claims wherein Koyasu was relied upon as a primary reference in an obviousness rejection of the claims, *without submitting of a declaration*. Because of the strength and success of those arguments, Applicants' saw no need in any previous response to submit a declaration to antedate the Koyasu reference. As the prosecution history shows, Applicants' argument against the Koyasu reference as a primary reference precipitated the citation of Weikhorst et al. as the primary reference in the Office Action dated May 27, and assertion of Koyasu only as a secondary reference. Applicants believe that the present invention is neither described nor suggested by the Weikhorst et al. and the Koyasu references, considered separately or in combination, as briefly considered below in Part II and other arguments of record. The declaration is therefore submitted for the sake of expediency, and not out of necessity, to secure allowance of the claims.

Applicants accordingly request reconsideration of the position taken in the Advisory Action that good and sufficient reasons why the declaration is necessary and was not earlier presented are required. Alternatively, and to the extent that the Office persists that good and sufficient reasons are required, good and sufficient reasons are believed to be evident from the remarks above.

Applicants therefore request entry of the declaration and consideration of the same together with the following remarks.

II. The Final Office Action

Claims 1-20 are now pending in this application. It is respectfully submitted that the pending claims define allowable subject matter.

An information disclosure statement is submitted herewith including a European search report generated pursuant to a foreign counterpart application to the present application. Applicants request consideration of the search report and in initialed form 1449 for Applicants records in the next communication from the Office.

The rejection of claims 1 and 3-9 under 35 U.S.C. § 102(e) as being unpatentable over Wiekhorst et al. (U.S. Patent Application Publication 2004/0055779) is respectfully traversed.

The rejection of claims 1 and 3-9 is respectfully traversed for the reasons set forth in Applicants previous response dated August 26, 2005. In the Final Office Action, it is asserted that nowhere in the Office Action does Weikhorst et al. disclose that the outer surface of the core element and the inner surface of the jacket are smooth, and that Applicants need to show the structural difference between the prior art and the claimed invention. In response, Applicants note that nowhere does Weikhorst et al. disclose that the outer surface of the core element and the inner surface of the jacket are not smooth, and that when reading the entire Weikhorst et al. as a whole and in context, Applicants' position with respect to the Weikhorst et al. reference is not unreasonable. The burden lies on the Patent Office to establish that the prior art teaches the claimed invention, and Applicants have rebutted the position taken in the previous Office Action with respect to the Wiekhorst reference and now being maintained in the Final Office Action. It is respectfully submitted that the Final Office Action improperly shifts the burden to the Applicants to prove a negative, namely that aspects of the claims are not found in the Weikhorst et al. reference, when Weikhorst et al. is simply silent regarding material aspects of the claims. The Final Office Action appears to overlook clearly recited elements of the claims that are simply not found in the Weikhorst et al. reference. Thus, the rejection is submitted to be procedurally improper and should be reconsidered and withdrawn.

Notwithstanding the above, submitted herewith is a Declaration of Prior Invention from one of the inventors that evidences conception and reduction to practice of the presently claimed

invention at a date prior to March 14, 2003 when the Weikhorst et al. patent application was filed. In light of the declaration, the Weikhorst et al. patent is antedated and disqualified as prior art that can be properly cited against the claims. The declaration therefore overcomes the rejection based upon Weikhorst et al.

For the reasons set forth above, Applicants respectfully request that the Section 102(e) rejection of claims 1 and 3-9 be withdrawn.

The rejection of claims 2 and 10-20 under 35 U.S.C. § 103(a) as being unpatentable over Weikhorst et al. in view of Koyasu et al. (U.S. Patent Application Publication 2003/0205402) is respectfully traversed.

As Weikhorst et al. has now been antedated and disqualified as prior art, the Section 103(a) rejection of claims 2 and 10-20 that rely upon Weikhorst et al. is now overcome.

Incidentally, Applicants note that the Koyasu reference has a filing date of April 28, 2003 that is after the filing date of Weikhorst et al. Thus, the Declaration of Prior Invention also antedates Koyasu and disqualifies Koyasu from prior art that can be asserted against the claims.

For the reasons set forth above, Applicants respectfully request that the Section 103 rejection of claims 2 and 10-20 be withdrawn.

In view of the foregoing remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



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